

REMARKS

Claims 1-26 were examined. Applicants hereby request further examination and reconsideration of the application in view of the following remarks.

Claims 1-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Laursen et al., U.S. Patent No. 6,847,618 (Laursen) in view of Simard et al., U.S. Patent No. 6,940,826 (Simard). The Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply a method and system for establishing a single multicast transmission which includes the mixed and unmixed voice signals to the conferees wherein the single multicast transmission must include the indicators to identify which voice signals associated with a conferee as disclosed by Simard into the teaching of Laursen. Applicant traverses these rejections for at least the following reasons.

The Federal Circuit has stated that when more than one reference or source of prior art is required in establishing the obviousness rejection, "it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification." *In re Lahu*, 747 F.2d 703, 705, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1984). The Examiner has the burden to explain why the prior art would appear to show the claimed subject matter and not simply the general aspects of the invention, which requires that the reference teachings "appear to have suggested the claimed subject matter." *In re Rinehart*, 531 F.2d 1048, 189 U.S.P.Q. 143, 147 (C.C.P.A. 1976).

Further, the Federal Circuit has added that when more than one reference or source of prior art is required in establishing the obviousness rejection, "it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification", and thus it is not enough that the Examiner present references that contain the assorted features of the invention. *In re Lahu*, 747 F.2d 703, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1984). *See also In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The Examiner must also show why it "would appear" that the references would have been combined. *See In re Friich*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1984). The Examiner must make all of the showings detailed in this paragraph in order to make a *prima facie* case of obviousness. The discussion below details how this burden has not been met.

The Examiner asserts that Laursen discloses receiving inputs from a number of

participants in a conferencing session, and combining those inputs into a first packet having a first payload and a second packet having a second payload, wherein the first packet includes at least one received input that is not included in the second packet. However, as noted by the the Examiner, Laursen fails to disclose, teach or suggest a method and system for combining received inputs into an output packet including a first sub-packet and a second sub-packet, wherein the first sub-packet as presently variously claimed in independent claims 1, 9, 17, 25 and 26. Instead, the Examiner relies upon Simard for this teaching, arguing that it would have been obvious to combine Laursen with Simard to provide a method and system for establishing a single multicast transmission including both the first and second packets.

Applicant strongly traverses the rejection. Simard discloses a single multicast transmission which includes a mixed voice signal, a primary voice signal, and a secondary voice signal. In contrast to Laursen, Simard also discloses "mixing the primary voice signal with the secondary voice signal using a well-known mixing algorithm as is currently used for combining two uncompressed voice signals such as PCM signals, the primary and secondary voice signals being combined into a single uncompressed voice signal (preferably a PCM signal); compressing the resulting mixed voice signal; *encapsulating the compressed mixed voice signal within a packet* format capable of transmission on a packet-based network". There is no motivation to packetize them in the manner of Laursen, and then combine them into a single packet, as Laursen is directly geared towards two individual packets. Consequently, Laursen and Simard fail to disclose, teach or suggest the method and systems of the present invention.

Moreover, the structure that would result from the Examiner's proposed combination does not meet the terms of claim 1. Such claim states "combining received inputs into *an output packet* including a first sub-packet and a second sub-packet, wherein the first sub-packet has a *first payload* and the second sub-packet has a *second payload*". In fact, the combination of Laursen and Simard would directly teach away from the present invention by Simard requiring only one combined signal in the packet not two packets with varying signals. Therefore, Simard teaches directly away from the proposed combination with Laursen. These two references simply show no motivation to be combined. The combination simply would not have *an output packet* including a first sub-packet and a second sub-packet, wherein the first sub-packet has a *first payload* and the second sub-packet has a *second payload*". Therefore, claim 1 as amended

is patentably distinct from the combination of Laursen and Simard.

Claims 2-8 depend from allowable base claim 1, therefore claims 2-8 are patentably distinct from the combination of Laursen and Simard.

At least similar arguments can be made for claims 9-26, therefore, claims 9-26 are also patentably distinct from the combination of Laursen and Simard.

The Federal Circuit has often observed that Section 103 speaks in terms of the time the invention was made, for it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight," *see Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 873, 228 U.S.P.Q. 90, 98 (Fed. Cir. 1985), (overruled on other grounds by *Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 46 U.S.P.Q.2d 1097 (Fed. Cir. 1998)). One must be wary of falling into the trap of hindsight reasoning, using the inventor's patent application as a guide and glue for the selection and combination of references or pieces of references that themselves contain no reason or suggestion for their combination.

An excellent summary of the law by the Federal Circuit is found in *In re Dembiczak*, 175 F.3d 994, 998, 50 U.S.P.Q.2d 1614, 1616 (Fed. Cir. 1999), from which we quote at length below:

Our analysis begins in the text of section 103 quoted above, with the phrase "at the time the invention was made". For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight," *see Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 873, 228 U.S.P.Q. 90, 98 (Fed. Cir. 1985) (overruled on other grounds by *Nobelpharma AB v. Implant Innovations, Inc.* 141 F.3d 1059, 46 U.S.P.Q.2d 1097 (Fed. Cir. 1998)), when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir.

1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998) (“the Board must identify specifically. . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them”); *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination “only by showing some objective teaching [leading to the combination]”); *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion “essential” to avoid hindsight); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297, 227 U.S.P.Q. 657, 667 (Fed. Cir. 1985) (district court’s conclusion of obviousness was error when it “did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination”). See also *Graham*, 383 U.S. at 18, 148 U.S.P.Q. at 467 (“strict observance” of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventors disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. See e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 U.S.P.Q. 543, 547 (Fed. Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.”) In this case, the Board fell into the hindsight trap.

See also M.P.E.P. 2143.01.

Applicant asks, why would one only use a small part of the teaching of Laursen, ignoring the rest, in seeking to combine Simard? The only teaching that supports this increasingly strained combination is the applicant’s specification. The Federal Circuit and the MPEP § 2143.01 specifically reject this use of the specification.

Accordingly, for at least the above reasons, it is submitted that claims 1-26 are patentable over the cited references. Withdrawal of the rejections of claims 1-26 is therefore requested.

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CONCLUSION

In view of the foregoing, it is submitted that the claims are in condition for allowance. Issuance of the present application as a patent is therefore solicited.

Attached herewith is a petition for a one-month extension of time under 37 C.F.R. 1.136(a). Please charge the \$120 fee under 37 C.F.R. 1.17(a)(1) to deposit account number 19-2179. It is believed no additional fees are due at this time. However, should the Examiner disagree, please charge the undersigned's Deposit Account No. 19-2179. Please also charge this deposit account, at any time during the pendency of this application, for any additional fees required, or credit any overpayment, pursuant to 37 CFR §1.25.

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Respectfully submitted,

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